having a top surface.

REMARKS

Applicant responds to the Office Action of November 6, 2002, in which claims 1-33, 35-40, 42-43, 46-77 are pending in the application. Claims 1-30 have been withdrawn from consideration.

The Examiner has erroneously listed claims 31-33, 35-40, 42, 43 and 46-77 as pending on Form PTO-326. Applicant wish to point out that claims 1-30 are pending in the application, but have been withdrawn from consideration.

Rejection of Claims 35, 59-60 under 35 U.S.C. §112

Claims 35 and 59-60 have been rejected under 35 U.S.C. §112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The Examiner contends that the claims contain method limitations that are given little to no patentable weight in article claims. Specifically, the Examiner objects to the following limitations: claim 35 recites the limitation that the non-adhesive forms are applied by printing; claim 59 recites that the thickness of the non-adhesive forms is sufficient to cause deformation of the facestock upon application to the substrate; and claim 60 recites the limitation that the non-adhesive material forms is applied by vacuum metallization or sputtering.

Applicant respectfully submits that the rejection of claims 35 and 59-60 under 35 U.S.C. §112, second paragraph, is improper. In support of Applicant's position, Applicant directs the Examiner's attention to MPEP §2173.05(p):

> A product-by-process claim, which is a product claim that defines the claimed product in terms of the process by which it is made, is proper. *In re Moeller,* 117 F.2d 565, 48 USPQ 542 (CCPA 1941); *In re Luck,* 476 F.2d 650, 177 USPQ 523 (CCPA 1973); *In re Steppan,* 394 F.2d 1013, 156 USPQ 143 (CCPA 1967); and *In re Pilkington,* 411 F.2d 1345, 162 USPQ 145 (CCPA 1969). A claim to a device, apparatus,

> manufacture, or composition of matter may contain a reference to the process in which it is intended to be used without being objectionable under 35 U.S.C. 112, second paragraph, so long as it is clear that the claim is directed to the product and not the process.

Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 31-59 under 35 U.S.C. §112, second paragraph, in view of the foregoing remarks.

Rejection of Claims 31-33, 35, 37, 42-43, 49-53, 55 and 59-62, 66-72 and 74 under 35 U.S.C. §102(b)

Claims 31-33, 35, 37, 42-43, 49-53, 55, 59-62, 66-72 and 74 have been rejected under U.S.C. §102(b) as being unpatentable over Calhoun et al. (US Pat. No. 5,141,790). The Examiner contends that Calhoun et al. disclose an adhesive article comprising a release liner having a top release surface and a bottom surface, a continuous layer of adhesive having a bottom surface and a top surface and end edges, wherein the bottom surface of the adhesive is adhered to the top release surface of the release liner such that the non-adhesive material forms have a top surface wherein the top surface of the material forms is even with or below the plane of the top release surface of the release liner.

Applicant has amended independent claims 31 and 59 to recite that the non-adhesive material forms comprise a polymeric ink. Calhoun et al. ('790) does not disclose embedded non-adhesive material forms that comprise a polymeric ink. Rather Calhoun et al. disclose individual particles or clumps of particles that are used to fill a depression in a carrier web. (See Col. 7, lines 48-50.) Claim 60 has been amended to clarify that the limitation "vacuum metalized or sputtering" refers to the non-adhesive material forms themselves, rather than the process by which they article is made. As one skilled in the art would know, vacuum metalized or sputtered materials are very thin films, i.e., on the nanometer scale. (See page paragraph 0033, lines 5-7.) Calhoun does not disclose vacuum metalized or sputtered embedded non-material forms. In view of the amendment to claims 31, 59 and 60 and the foregoing remarks, Applicant respectfully requests withdrawal of the rejection of claims 31-33, 35, 37, 42-43, 49-53, 55, 59-62, 66-72 and 74 under U.S.C. §102(b).

Rejection of Claims 31-33, 35-40, 42, 46, 49-52, 55, 59-67, 69-71 and 74 under 35 U.S.C. §103(a)

Claims 31-33, 35-40, 42, 46, 49-52, 55, 59-67, 69-71 and 74 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Rusincovitch et al. (US Pat. No. 5,675,787). The Examiner contends that Rusincovitch discloses an adhesive article comprising a release liner, a continuous layer of adhesive adhered to the release liner and a pattern of non-adhesive material forms embedded into the release surface of the release liner. The Examiner has relied, in part, on Figure 4B of Rusincovitch as support for his position that the non-adhesive forms are embedded into the release surface. The Examiner has also relied on Applicant's specification for a teaching to modify the article of Rusincovitch. The Examiner contends that, in the absence of unexpected results, Rusincovitch et al. teach an equivalent method of forming the release liner and the non-adhesive material forms would inherently become embedded to a height equal to or below the top plane of the release liner given the equivalence in the method of forming the release liner.

Applicant respectfully disagrees with the Examiner's contention. Rusincovitch does not disclose, teach or suggest embedding a pattern of non-adhesive material forms in the release surface of the release liner. Rather, Rusincovitch teaches that the non-adhesive forms are printed on the surface of the release liner. (Col. 5, line 66 to col. 6 line 3; and col. 6, lines 57-59) Figure 4B of Rusincovitch shows the non-adhesive forms on the surface, and not embedded into the release liner. Rusincovitch further states at column 6, lines 60-61 that the printed ink spacers protrude from the flat surface of the release liner. Upon rolling of the adhesive article of Rusincovitch, the pattern of non-adhesive spacers transfers to from the release coating to the adhesive coating. (Col. 4, lines 56-58.) Rusincovitch does not disclose, teach or suggest that the spacers are fully embedded into the release coatings such that the upper surface of the spacers is even with or below the plane of the upper surface of the release coating. In support for his position that it would have been obvious to modify the teachings of Rusincovitch to fully embed the spacers into

the release liner, the Examiner has relied on Applicant's own specification disclosure of embedding by using pressure and/or heated rollers and a platen. Such reliance on Applicant's own disclosure for a teaching to modify the Rusincovitch reference is improper. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 31-33, 35-40, 42, 46, 49-52, 55, 59-67, 69-71 and 74 under 35 U.S.C. §103(a).

Rejection of Claims 39-40 under 35 U.S.C. 103(a)

Claims 39-40 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun et al. (US Pat. No. 5,141,790) in view of GB 1,511,060. Specifically, the Examiner has stated that although Calhoun et al. teach that the non-adhesive material forms are substantially uniformly distributed, Calhoun et al. fail to teach that the substantially uniform distribution can be in the form of a grid pattern which intersects at least 50% of the lines at the edges of the article. The Examiner contends that the grid pattern taught by GB '060 would be an obvious modification of Calhoun's non-adhesive spacers to successfully obtain the air egress property.

Applicant respectfully disagrees with the Examiner's contention. GB '060 teaches an article with improved degassing properties comprised of an air impermeable plastic sheet and an underlying adhesive. The shape of the adhesive on the edge that adheres to a surface consists of elongated ridges and or recessions. Degassing of the article occurs when the adhesive layer is exposed to pressure and heat so that the adhesive layer collapses on the air spaces and conforms to a surface. GB '060 does not teach or suggest that patterned shapes could be made with non-adhesive material or that non adhesive material forms would be desirable. Calhoun teaches that the clumps of particles are substantially uniformly distributed over the pressure sensitive adhesive. While the teachings of GB '060 may be "in line with those of Calhoun" as stated by the Examiner, neither Calhoun nor GB '060 disclose, teach or suggest non-adhesive material forms comprising a polymeric ink that are embedded into the release liner at or below the surface of the release liner. For these reasons, Applicant respectfully submits that the rejection of claims 39 and 40 has been overcome and respectfully requests withdrawal of the rejection.

Rejection of Claims 47-48 under 35 U.S.C. § 103(a)

Claims 47 and 48 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Calhoun et al. in view of Plamthottam et al. (US Pat. No. 5,180,635). The Examiner contends that Calhoun teaches the adhesive article of Applicant's invention and that although Calhoun fails to teach porous elastomeric microspheres, it would have been obvious to one of ordinary skill in the art to modify Calhoun to include porous elastomeric microspheres as taught by Planthottam et al. in order to reduce the density of the carrier layers, improve peel adhesion and thereby improve conformability and the strength of the adhesive article.

Applicant respectfully disagrees with the Examiner's contention. Plamthottam et al. is directed to a pressure sensitive adhesive tape in which the adhesive layer is made up of a rubber based adhesive matrix within which microspheres are mixed. The microspheres may be solid, hollow or porous and rigid or elastomeric. Planthottam does not disclose, teach or suggest an adhesive article having non-adhesive material forms embedded into the surface of a release liner. Rather, Planthottam teaches microspheres mixed into an adhesive matrix. There is no teaching or suggestion in either Planthottam or Calhoun to substitute the microspheres in the adhesive matrix of Planthottam for the spaced clumps of Calhoun. Furthermore, even if there were a teaching or suggestion for such a modification, the resulting adhesive article would not be the adhesive article as claimed by Applicant. As discussed above, Applicant's claimed adhesive article includes non-adhesive material forms comprising a polymeric ink that are embedded into the release liner even with or below the upper surface of the release liner. Neither Calhoun nor Planthottam disclose, teach or suggest the adhesive article as claimed by Applicant. Therefore, Applicant respectfully requests withdrawal of the rejection of claims 47-48 under 35 U.S.C. §103(a) based on Calhoun et al. ('790) in view of Planthottam.

Rejection of Claims 54, 56-58, 73 and 75-77 under 35 U.S.C. § 103(a)

Claims 54, 56-58, 73 and 75-77 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Calhoun et al. (US Patent No. 5,141,790) in view of Calhoun (US Patent No. 5,585,178). The Examiner contends that it would have been obvious through

routine experimentation, based on the teachings of Calhoun ('178) to have used multiple layers of adhesive in an adhesive article for the purpose of providing varying properties to the article, wherein one adhesive provides repositionability and the second adhesive builds bond strength through aging.

Applicant respectfully disagrees with the Examiner's contention. Calhoun ('178) teaches a composite adhesive, or in other words, a single adhesive layer made up of two distinct adhesives having different viscoelastic properties. The Examiner has mischaracterized Calhoun ('178). Fig. 4 upon which the Examiner has relied for the teaching of two distinct adhesive layers is actually an illustration of roll of tape that is partially unwrapped. (Col. 7, lines 1-5.) Applicant's invention as claimed in claims 56-58 and claims 75-77 includes two separate adhesive layers, separated by a release liner. Applicant's invention as claimed in claims 54 and 73 includes two release liners separated by an adhesive layer. Furthermore, as discussed above, Calhoun ('790), does not disclose, teach or suggest the adhesive article as claimed by Applicant, and Calhoun ('178) does not cure the deficiencies of Calhoun ('790). Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 54, 56-58, 73 and 75-77 under 35 U.S.C. § 103(a).

In view of the foregoing amendment and remarks, Applicant respectfully submits that the Examiner's rejections have been overcome and respectfully requests allowance of claims 31-33, 35-40, 42, 43 and 46-77.

Respectfully submitted,
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APPENDIX

Following is a marked-up version of the amended claim.

31. (Twice amended) An adhesive article comprising:

a release liner having a top release surface and a bottom surface;

a continuous layer of adhesive having a bottom surface and a top surface and end edges, wherein the bottom surface of the adhesive is adhered to the top release surface of the release liner; and

a pattern of non-adhesive material forms embedded into the top release surface of the release liner, said non-adhesive material forms comprising a polymeric ink and having a top surface, wherein the top surface of the non-adhesive material forms is even with or below the plane of the top release surface of the release liner.

59. (Twice amended) An adhesive article comprising:

a release liner having a release surface and a bottom surface;

a continuous layer of adhesive having a bottom surface and a top surface and end edges, wherein the bottom surface of the adhesive is adhered to the release surface of the release liner;

a pattern of non-adhesive material forms embedded into the release surface of the release liner, wherein the non-adhesive material forms comprise a polymeric ink and wherein the top surface of the non-adhesive material forms is even with or below the plane of the release surface of the release liner; and

a facestock adhered to the top surface of the adhesive layer, wherein the thickness of the non-adhesive material forms is sufficient enough to cause deformation of the facestock upon application of the adhesive article to a substrate.

60. (Amended) An adhesive article comprising:

a release liner having a release surface and a back surface;

a continuous layer of adhesive having a front surface and a back surface and end edges, wherein the front surface of the adhesive is adhered to the release surface of

the release liner; and

a pattern of vacuum metalized or sputtered non-adhesive material forms embedded into the release surface of the release liner, said non-adhesive material forms having a top surface[, wherein the pattern of non-adhesive material forms is applied by vacuum metalization or sputtering].